

ESTTA Tracking number: **ESTTA499394**

Filing date: **10/10/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Urban Decay Cosmetics LLC		
Entity	limited liability company	Citizenship	Delaware
Address	833 West 16th Street Newport Beach, CA 92663 UNITED STATES		

Attorney information	Susan M. Natland Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@knobbe.com Phone:(949) 760-0404
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### Registration Subject to Cancellation

Registration No	3932354	Registration date	03/15/2011
Registrant	TOO FACED COSMETICS, LLC 17361 ARMSTRONG AVE. IRVINE, CA 92614 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 003. First Use: 2009/12/00 First Use In Commerce: 2009/12/00  
All goods and services in the class are cancelled, namely: Cosmetics; Eye make-up; Eyebrow cosmetics; Eyeshadow; Make-up kits comprised of eyeshadows

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Common law rights as asserted in the Petition for Cancellation.

### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	NAKED, URBAN DECAY NAKED and NAKED URBAN DECAY		
Goods/Services	personal care and cosmetic products and related services		

Attachments	URBDEC 214N Petition for Cancellation.pdf ( 8 pages )(305162 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/susan natland/
Name	Susan M. Natland
Date	10/10/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Urban Decay Cosmetics LLC,  
Petitioner,  
v.  
Too Faced Cosmetics, LLC,  
Respondent.

) I hereby certify that this correspondence and all marked attachments  
) are being electronically filed with the Trademark Trial and Appeal  
) Board through their web site located at <http://esta.uspto.gov> on:

) October 10, 2012  
) (Date)

)   
) Susan M. Natland

**PETITION FOR CANCELLATION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Sir or Madam:

Petitioner, Urban Decay Cosmetics LLC ("Urban Decay"), a Delaware limited liability company, located and doing business at 833 West 16th Street, Newport Beach, California 92663, believes it is or will be damaged by the continued registration of the mark shown in Registration No. 3,932,354 ("Respondent's Registration") filed on January 7, 2010 by Too Faced Cosmetics, Inc., assigned to Too Faced Cosmetics, LLC on December 22, 2011, and registered on March 15, 2011, and hereby opposes the same.

A description of Respondent's Registration is as follows:

Mark : NAKED EYE  
Reg. No. : 3,932,354  
Filed : January 7, 2010  
Registered : March 15, 2011  
Int'l. Class : 3  
Goods : COSMETICS; EYE MAKE-UP; EYEBROW COSMETICS;  
EYESHADOW; MAKE-UP KITS COMPRISED OF  
EYESHADOWS

Alleged Date  
of First Use : December 2009

As grounds for cancellation of Respondent's Registration, it is alleged:

1. Urban Decay is world famous for innovative, cutting-edge, high-quality goods and unique personal care and cosmetic products and related services ("Urban Decay's Goods and Services").

2. For many years prior to the filing date of Application Serial No. 77/907,408 ("Respondent's Application"), which is the application that matured into Respondent's Registration, and prior to the date of first use alleged in Respondent's Registration, Urban Decay has designed, developed, marketed, manufactured, promoted, offered and sold personal care and cosmetic products ("Urban Decay's Goods") in connection with various names and marks. Among the marks owned by Urban Decay are the marks NAKED, URBAN DECAY NAKED and NAKED URBAN DECAY (individually and/or collectively, the "NAKED Marks").

3. For many years prior to the filing date of Respondent's Application and prior to Respondent's alleged date of first use in Respondent's Registration, Urban Decay has used the NAKED Marks in connection with cosmetics. Specifically, since at least as early as August 2002, Urban Decay has extensively used the NAKED Marks continuously in connection with Urban Decay's Goods.

4. For over two decades, Urban Decay has spent considerable time, effort and money in developing its reputation as a leader in the personal care and cosmetic space. As a result of this investment and the popularity and widespread commercial success of its products, including its products offered in connection with its NAKED Marks, Urban Decay has developed a tremendous amount of goodwill in its NAKED Marks.

5. Urban Decay's use of the NAKED Marks has been valid and continuous since at least as early as the dates of first use indicated above and has not been abandoned. The NAKED Marks are symbolic of extensive goodwill and consumer recognition built up by Urban Decay

through time and effort in advertising, promotion and sales.

6. In view of the substantial similarity of the respective marks and the related nature of the goods of the respective parties, Respondent's mark NAKED EYE so resembles the NAKED Marks previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

7. Since at least as early as the dates of first use alleged above, Urban Decay has consistently used its NAKED Marks in interstate commerce. Urban Decay's NAKED Marks by virtue of substantial use, recognition and promotion, have acquired great value as an indicator of Urban Decay and Urban Decay's Goods, and distinguish them from the goods and services of others.

8. Since at least as early as the dates of first use stated above, Urban Decay has used its NAKED Marks in connection with the sale and promotion of Urban Decay's Goods. Such use has been valid and continuous, and has not been abandoned.

9. If Respondent is allowed to maintain the registration for the mark in Respondent's Registration, Respondent's corresponding prima facie exclusive right to use the NAKED EYE mark nationwide will conflict with Urban Decay's lawful right to use its NAKED Marks.

10. Urban Decay is the owner of U.S. Application Serial No. 85/591,321 for the mark NAKED BASICS (the "'321 Application"). Respondent has filed an Extension of Time to Oppose in connection with the '321 Application. Thus, Respondent itself believes there is a likelihood of confusion between the mark shown in the '321 Application and the mark in Respondent's Registration.

11. As indicated above, Respondent has filed an Extension of Time to Oppose in connection with the '321 Application. Thus, Respondent itself believes there is a likelihood of confusion between the NAKED Marks and Respondent's use and registration of marks

containing or consisting of the term NAKED.

12. Since at least as early as the dates of first use stated above, Urban Decay has used its NAKED Marks. Such use has been valid and continuous, and has not been abandoned. The relevant class of the public has come to associate Urban Decay with the NAKED Marks.

13. Since a date well prior to the filing date of Respondent's Application, Urban Decay has used its NAKED Marks. Such use has been valid and continuous, and has not been abandoned. As a result of this use, well prior to the filing date of Respondent's Application, the relevant class of the public has come to associate Urban Decay with the NAKED Marks.

14. Since a date well prior to the alleged date of first use listed in Respondent's Registration, Urban Decay has used its NAKED Marks. Such use has been valid and continuous, and has not been abandoned. As a result of this use, well prior the alleged date of first use listed in Respondent's Registration, the relevant class of the public has come to associate Urban Decay with the NAKED Marks.

15. Urban Decay has invested substantial amounts of time, effort and money in the NAKED Marks throughout the United States. By reason of Urban Decay's widespread and continuous use of the NAKED Marks, Urban Decay has extensive, non-registered statutory and common law rights in the NAKED Marks.

16. Urban Decay through sales, advertising and promotion of Urban Decay's Goods under the NAKED Marks, since a date prior to the filing date of Respondent's Registration, has built up at great expense and effort, valuable goodwill and recognition symbolized by the NAKED Marks.

17. Urban Decay through sales, advertising and promotion of Urban Decay's Goods under the NAKED Marks, since a date prior to the alleged date of first use listed in Respondent's Registration, has built up at great expense and effort, valuable goodwill and recognition symbolized

by the NAKED Marks.

18. Urban Decay's Goods provided in connection with the NAKED Marks, as well as Urban Decay's Goods and Services in general, have received widespread success.

19. In view of Urban Decay's prior rights in the NAKED Marks, Respondent is not entitled to registration of the NAKED EYE mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

20. Respondent's mark NAKED EYE is likely to cause confusion with the NAKED Marks. Additionally, Respondent's Registration identifies goods identical to or closely related to Urban Decay's Goods and Services, detailed above. As such, when the mark NAKED EYE is used on or in connection with the goods identified in Respondent's Registration, it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

21. Respondent's mark NAKED EYE is likely to cause confusion with the NAKED Marks. Additionally, Respondent's Registration identifies goods identical to or closely related to the goods provided by Urban Decay in connection with its NAKED Marks. As such, Respondent's NAKED EYE mark and use thereof is likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that Respondent's goods originate with Urban Decay or are otherwise authorized, licensed or sponsored by Urban Decay.

22. Respondent has no license, consent or permission from Urban Decay to use or register marks containing the term NAKED.

23. The first term of the mark shown in Respondent's Registration, NAKED, is identical to the term NAKED in Urban Decay's NAKED Marks.

24. The dominant portion of the mark NAKED EYE is NAKED.

25. The term EYE is disclaimed in Respondent's Registration.

26. The goods Urban Decay provides in connection with its NAKED Marks are identical to the goods identified in Respondent's Registration.

27. Respondent is providing cosmetics in connection with the mark NAKED EYE.

28. Urban Decay provides cosmetics.

29. Urban Decay provides cosmetics in connection with the mark NAKED.

30. Urban Decay provides cosmetics in connection with the NAKED Marks.

31. Urban Decay and Respondent are competitors.

32. Urban Decay used a mark containing or consisting of the term NAKED prior to Respondent's first use of the mark NAKED EYE.

33. Urban Decay used a mark containing or consisting of the term NAKED prior to Respondent's first use of any mark consisting of or containing the term NAKED.

34. Urban Decay used a mark containing or consisting of the term NAKED prior to Respondent's first use of the mark NAKED EYE.

35. Urban Decay used the NAKED Marks prior to Respondent's first use of the mark NAKED EYE.

36. Urban Decay used a mark containing or consisting of the term NAKED prior to Respondent's alleged date of first use set forth in Respondent's Registration.

37. Urban Decay used the NAKED Marks prior to Respondent's alleged date of first use set forth in Respondent's Registration.

38. Urban Decay used a mark containing or consisting of the term NAKED prior to Respondent's alleged date of first use set forth in Respondent's Registration.

39. Urban Decay used the NAKED Marks prior to the filing date of Respondent's Application.

40. Urban Decay used a mark containing or consisting of the term NAKED prior to the



filing date of Respondent's Application.

41. There are no limitations as to the channels of trade in Respondent's Registration.

42. By reason of all the foregoing, Urban Decay will be gravely damaged by the continued registration of the mark shown in Respondent's Registration because registration of this mark would be in violation of Urban Decay's trademark rights.

WHEREFORE, Urban Decay prays that Respondent's Registration be cancelled.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 10, 2012

By: \_\_\_\_\_

  
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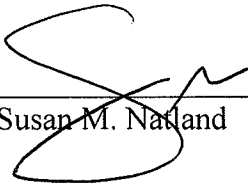
Urban Decay Cosmetics LLC

**CERTIFICATE OF SERVICE**

I hereby certify that I served copies of the foregoing **PETITION FOR CANCELLATION** upon Respondent's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid on October 10, 2012 addressed to each of the attorneys listed below as follows:

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